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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,725	08/06/2003	Stuart Neil Prince	1324030A	8868

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EXAMINER	
FORD, VANESSA L	

ART UNIT	PAPER NUMBER
1645	

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/635,725	Applicant(s) PRINCE ET AL.	
	Examiner Vanessa L. Ford	Art Unit 1645	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): claims 1-16 under 35 U.S.C. 103(a), Hoopinggarner et al.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: *NONE*.
   Claim(s) objected to: *2-6*.
   Claim(s) rejected: *1 and 7-16*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Advisory Attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: Advisory Attachment.

Advisory Attachment

1. This action is in response to Applicant's amendment and response filed January 19, 2006.

Rejection Withdrawn

2. In view of Applicant's response the rejection of claims 1-16 under 102/103 is withdrawn, page 4, paragraph.

Rejection Maintained

3. The rejection of claims 1 and 7-16 under 35 U.S.C. 102(b) is maintained for the reasons set forth on pages 3-4, paragraph 3 of the previous Office Action.

The rejection was on the grounds Oldroyd et al teach that honeybee colonies were treated with various oxytetracycline hydrochloride (OTC) preparations at the same time of inoculation with *Bacillus larvae* spores. Oldroyd et al teach that colonies were inoculated with a comb (apicultural delivery vehicle) containing larvae sprayed with 20 ml of *Bacillus larvae* (page 692). Claim limitations such as "the composition of claim 1, wherein the inoculum comprises one or more microorganisms that produce one or more antibiotics active against one or more bee pathogens", "the composition of claim 7, wherein the antibiotics are active against at least one of *Melissococcus pluton* and *Paenibacillus larvae subsp. larvae*", "the composition of claim 7, wherein the antibiotics) are bacteriolytic" and the composition of claim 7, wherein the antibiotics are the anti-*Melissococcus pluton* and/or the anti-*Paenibacillus larvae subsp. larvae* antibiotics found in *Paenibacillus larvae subsp. pulvfaciens* would be inherent in the teachings of the prior art. The composition of Oldroyd et al anticipate the claimed invention.

Since the Office does not have the facilities for examining and comparing applicant's composition with the composition of the prior art, the burden is on the applicant to show a novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the composition of the prior art does not possess the same material structural and functional characteristics of the claimed composition). See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

Applicant's Arguments

A) Applicant urges that Oldroyd et al do not teach an inoculum containing organisms that are non-pathogenic to bees. Applicant urges that the claims recite the limitation "...whereby a remedial and/or protective microflora is established within the hive or the bee colony. Applicant urges that all of the colonies in the absence of OTC developed AFB disease. Applicant urges that AFB disease was prevented by OTC treatment.

B) Applicant do not agree with the definition of non-pathogenic in the Office action. Applicant refers to Annex A-D to support their position.

Examiner's Response to Applicant's Arguments

Applicant's arguments filed January 19, 2006 have been fully considered but they are not persuasive.

A) Oldroyd et al teach honey bee colonies were treated with OTC preparations at the same time of inoculation with *Bacillus larvae* spores. Oldroyd et al teach that were American Foulbrood (AFB) disease-free at the time of sampling and did not subsequently develop disease signs (page 691). It should be remembered that the claim limitation "...whereby a remedial and/or protective microflora is established within the hive or the bee colony" is being viewed as limitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

performing the intended use, then it meets the claim. It should be further noted that the claims recite the transitional or open claim language "comprising" which means that other components may be present in the compositions. See MPEP 2111.03.

B) To address Applicant submission of annexes A-D, it should be noted that Applicant has provided these documents to support their position that *Paenibacillus larvae subsp. larvae* (*Bacillus larvae*) are pathogenic to bees. However, Annex C (Oxytetracycline Sensitivity of *Paenibacillus larvae subp. larvae)* points out that *Paenibacillus larvae subsp. larvae* are sensitive to OTC and no resistance to OTC appears to have developed over passed 15 to 16 years. This document provides a support as to why the skilled artisan would treat honeybee colonies with OTC preparations at the same time inoculation with *Bacillus larvae* spores as evidence by Oldroyd et al. This may explain why no colonies subsequently develop disease signs. Applicant provided in annex A, a definition of the word "pathogen". A pathogen is any agent that causes disease. The prior art teaches that non colonies subsequently develop disease signs. Therefore, the composition of the prior art teaches an inoculum of microorganisms that are non-pathogenic to bees.

The composition of the prior art teaches the claimed invention. Applicant has provided no side-by-side comparison to show that the claimed product differs from that of the prior art. Therefore, the teachings of Oldroyd et al anticipate the claimed invention.

Status of Claims

4. No claims are allowed. Claims 2-6 are objected to as being dependent upon a rejected base claim.

Conclusion

5. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308–0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 872-9306.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (571) 272-0857. The examiner can normally be reached on Monday – Friday from 9:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (571) 272-0864.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov./>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vanessa L. Ford
Biotechnology Patent Examiner
April 4, 2006

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